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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,628	02/12/2001	Ursula Murschall	00/057 MFE	9521

7590  
ProPat, L.L.C.  
2912 Crosby Road  
Charlotte, NC 28211

05/21/2003

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/21/2003

*10*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/781,628

Applicant(s)

MURSCHALL ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Examiner's Comment*

1. The Examiner notes that claims 14-16, as presented in the previous Amendment filed 6/24/2002 and in the Amendment filed 2/26/2003 are inconsistent with originally filed claims 14-16 (e.g., the presence of the phrase "preferably from 0.5 to 3.0% by weight" with respect to the UV stabilizer). The phrase in question appears in the original foreign priority document, but was apparently deleted in the original specification filed on 2/12/2001. However, the phrase was restored in the claim amendments in the previous Amendment filed 6/24/2002 and in the Amendment filed 2/26/2003. Since this change was not indicated in the marked copies of the claims, the Examiner requests that Applicant clearly and explicitly indicate whether Applicant intended to include the phrase in question in the claims or whether they constitute an inadvertent typographical error (and take appropriate steps to correct such).

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-28 of copending Application No. 09/421,068, in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301) as set forth in the previous Office Action mailed 9/26/2003.

Application 09/421,068 claims a white, biaxially oriented film comprising at least one layer comprising polyester and the specified cycloolefin, as well as other features such as the recited whiteness, opacity, and gloss values; and the presence of additional layers, etc. However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film

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claimed in Application No. 09/421,068 in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches as indicated in claims 1-2 to incorporate the additives into the polyester composition. It would have been obvious to incorporate other fillers or pigments into the film in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual properties and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-16 of copending Application No. 09/791,447, in view of in view of UK PATENT APPLICATION GB 2344596

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(hereinafter GB '596) or BALOG ET AL (US 3,950,301) as set forth in the previous Office Action mailed 9/26/2003.

Application 09/791,447 claims a white, biaxially oriented film comprising at least one layer comprising polyester, white pigment, and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, gloss values, and the use of regrind material; and the presence of additional intermediate and/or outer layers, etc. However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in Application No. 09/781,628 in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have also utilized conventional compounding methods such as masterbatches to incorporate the additives into the

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polyester composition. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/781,802 or claims 1-15 of copending Application No. 09/781,722 in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301), and in view of PEIFFER ET AL (US 5,955,181).

Applications Nos. 09/781,802 and 09/781,722 each claim a white, biaxially oriented film comprising at least one layer comprising polyester and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, gloss values, use of pigment, and the presence of additional intermediate and/or outer layers, etc. However, the reference does not explicitly disclose the use of regrind material and in the case of 09/781,722, the recited UV stabilizer or in the case of 09/781,802, the recited flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

PEIFFER ET AL '181 discloses that it is well known in the art to incorporate 20-50 wt% regrind or recycled material into thermoplastic polyester films (lines 30-35, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate regrind material into the films claimed in Applications Nos. 09/781,802 and 09/781,722 in order to reduce costs and conserve resources. It also would have been obvious to one of ordinary skill in the art to incorporate both conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the claimed white films in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches to incorporate the additives into the polyester composition. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore



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the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 103*

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

SASAKI ET AL (US 5,843,578),

in view of REIDEL ET AL (US 5,869,586) or MINAMI ET AL (US 5,179,171) or

KAJIURA ET AL (US 4,614,778),

and in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or  
BALOG ET AL (US 3,950,301),

and in view of PEIFFER ET AL (US 5,955,181).

SASAKI ET AL discloses a biaxially oriented film comprising polyester and 3-40 wt% of an incompatible cyclic olefin resin (line 25, col. 4 to line 18, col. 5), wherein the film has good gloss, whiteness, and opacity (lines 51-56, col. 5; lines 18-24, col. 10) as recited in claims 1, 14-16, wherein the film may further contain pigments, stabilizers, and other additives for improved opacity (lines 19-33, col. 5), and may be further laminated and/or coated with a functional layer (lines 42-45, col. 9; line 65, col. 9 to line 12, col. 10) as recited in claims 10-12. However, the reference does not explicitly disclose the recited Tg values of the cycloolefin.

REIDEL ET AL discloses known cycloolefin polymers derived from norbornene, tetracyclododecene and/or cyclopentene (lines 25-50, col. 8) which have typical Tg values of 143

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C to 193 C (Table) as recited in claims 1, 3-5, 14-16. MINAMI ET AL discloses known cycloolefin polymers derived from octahydronaphthalene-based monomers and optionally norbornene and/or cyclopentene (columns 6-8; line 52, col. 10 to line 9, col. 11) which have Tg values of 10-200 C (lines 15-20, col. 13) as recited in claims 1, 3-5, 14-16. KAJIURA ET AL discloses known cycloolefin polymers derived from octahydronaphthalene-based monomers and optionally norbornene and/or cyclopentene (columns 4-6; 18-48, col. 10) which have Tg values of 30-220 C (lines 14-20, col. 8) as recited in claims 1, 3-5, 14-16.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

PEIFFER ET AL '181 discloses that it is well known in the art to incorporate 20-50 wt% regrind or recycled material into thermoplastic polyester films (lines 30-35, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate known cycloolefin polymers as disclosed in REIDEL ET AL or MINAMI ET AL or KAJIURA ET AL in the polyester film of SASAKI ET AL in order to produce white films with useful mechanical and optical properties. It also would have been to

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obvious to utilize regrind material in the prior art films in order to reduce waste and conserve resources as disclosed in PEIFFER ET AL '181. One of ordinary skill in the art would have incorporated combination of conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and/or organic phosphorus flame retardants into at least one layer of the disclosed white film using established compounding methods in order to improve durability, fire resistance, and color stability. It would have been obvious to use conventional film-finishing methods, additional pigments or additives, and/or additional surface layers or coatings in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide added protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

7. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

JAPANESE PATENT APPLICATIONS 05-009319 or 05-140349 or 11-035717

(hereinafter JP '319 and JP '349 and JP '717, respectively),

in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301),

and in view of PEIFFER ET AL (US 5,955,181).

JP '319 discloses a biaxially oriented film comprising polyester and 5-50 wt% of an incompatible cyclic olefin resin derived from norborene ([0010]) having a typical Tg of 98-100 C (Table 3), wherein the film has good gloss, whiteness, and opacity, and wherein the film may further contain pigments, stabilizers, and other additives ([0030]) as recited in claims 1, 3-5, 10, 14-16, and may be further laminated and/or coated with additional layers ([0032]) as recited in claims 11-12.

JP '349 discloses a biaxially oriented film comprising polyester and 5-50 wt% of an incompatible cyclic olefin resin derived from norborene ([0009], [0020]) having a typical Tg of 135-205 C (Table 1), wherein the film has good gloss, whiteness, and opacity, and wherein the film may further contain pigments, stabilizers, and other additives ([0029]) as recited in claims 1, 3-5, 10, 14-16, and may be further laminated and/or coated with additional layers ([0031]) as recited in claims 11-12.

JP ' 717 discloses an opaque biaxially oriented film comprising polyester and 5-80 parts by weight of an incompatible cycloolefin resin derived from norborene having a typical Tg of 120-270 C ([0023], Abstract) wherein the film may further contain pigments, stabilizers, and other additives ([0061]) as recited in claims 1, 3-5, 10, 14-16, which may be further laminated and/or coated with additional layers ([0070]) as recited in claims 11-12.

However, the references do not explicitly disclose the specified UV stabilizers and flame retardants or the use of regrind.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

PEIFFER ET AL '181 discloses that it is well known in the art to incorporate 20-50 wt% regrind or recycled material into thermoplastic polyester films (lines 30-35, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the polyester/cycloolefin blends as disclosed in JP '253 and JP '319 and JP '349 and JP '717 as the base layer of a multilayer film in order to produce white films with useful mechanical and optical properties. It also would have been to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in Application No. 09/421,068 in order to improve durability, fire resistance, and color stability. It also would have been to obvious to utilize regrind material in the prior art films in order to reduce waste and conserve resources as disclosed in PEIFFER ET AL '181. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches as indicated in claims 1-2 to incorporate the additives into the polyester composition. It would have been obvious to use

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conventional film-finishing methods, additional pigments or additives, and/or additional surface layers or coatings in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual and physical properties required by a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide added protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

### ***Response to Arguments***

8. Applicant's arguments filed 2/26/2003 have been fully considered but they are not persuasive.

(A) Applicant's arguments with POLYMER TECHNOLOGY have been considered but are moot in view of the new ground(s) of rejection. PEIFFER ET AL '181 clearly discloses it is well known in the art to incorporate up to 50 wt% recycled or regrind material in polyester films.

(B) Applicant argues that the references fail to disclose the prior art fails to disclose or suggest the use of regrind in films for synthetic paper or food packaging. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is

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noted that the features upon which applicant relies (i.e., food packaging, synthetic paper, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, since the claims do not specify the type or quality of regrind used, the mere use of regrind does not mean that a film is automatically unsuitable for certain applications with rigorous optical and/or safety requirements (e.g., a high quality regrind may be substantially similar to virgin material in regards to quality, purity, and performance). It is the Examiner's position that given the clear economic and environmental benefits of using regrind material, one of ordinary skill in the art would be motivated to use such recycled materials unless clearly precluded by an explicit teaching or by particular product requirements.

(C) In response to applicant's argument that the prior art fails to teach or suggest the use of the recited cycloolefins to reduce yellowing in materials containing regrind, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Since the use of recycled materials has well established cost and environmental benefits, Applicant has not provided probative evidence of criticality or unexpected results commensurate in scope with the present claims.

(D) While the examples in the specification indicate that that certain cycloolefin-containing compositions produce films with reduced yellowing in films incorporating regrind material, the showing in the specification is not commensurate in scope with the present claims,

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especially in regards to the Tg, type and amount of additives such as UV absorber, white pigment, brighteners, etc. Applicant has not provided probative evidence that similar non-yellowing properties are present in films containing COCs of different Tg values, or the use of different types and/or amounts of pigments and additives, especially when the specification fails to clearly set forth the compositions of the comparative Examples. Furthermore, the Examiner notes that Applicant has not provided evidence of criticality and/or unexpected results based on comparisons against the closest prior art as represented by the JP '319 and JP '349 and JP '717, which each explicitly disclose polyester/cycloolefin blends. The Examiner also points out that additives such as UV absorbers, brighteners, etc. have well known effects and functions; therefore some degree of improvement in UV resistance and coloration is only to be expected from their use.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

May 15, 2003



Vivian Chen  
Primary Examiner  
Art Unit 1773